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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/834,886	04/16/2001	Hideki Umeyama	TAN-285	5674

7590 10/30/2002
SHERMAN & SHALLOWAY
413 North Washington Street
Alexandria, VA 22314

EXAMINER

FERNSTROM, KURT

ART UNIT	PAPER NUMBER
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3712

DATE MAILED: 10/30/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/834,886

Applicant(s)

UMEYAMA ET AL.

Examiner

Kurt Fernstrom

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5,6,8 and 9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5,6,8 and 9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 22 August 2002 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: The specification appears to be a literal translation into English from a foreign document and is replete with grammatical and idiomatic errors..

Appropriate correction is required.

Drawings

2. The corrected or substitute drawings were received on August 22, 2002. These drawings are approved.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

4. Claim 1 is rejected under 35 U.S.C. 102(a) as being anticipated by Sugiura, et al, "Creating Cataract in a Pig Eye" ("Sugiura"). Sugiura discloses a model of an eye with cataract comprising a pig's eye which has hardening chemicals injected into the lens.

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Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2, 3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sugiura.

While Sugiura does not disclose that the lens capsule is empty as claimed in claims 2 and 3, injecting chemicals into an empty lens capsule would have been obvious to one of ordinary skill in the art as an aesthetic choice of design and for the purpose of allowing the user to simulate a cataract solely using chemicals. Also, although the location of the injection of claim 5 is not disclosed by Sugiura, the claimed location does not appear to yield any unexpected advantages over the location disclosed by Sugiura, and thus would also have been obvious to one of ordinary skill in the art as an aesthetic choice of design.

7. Claims 6, 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Creating Cataract in view of Wilder, NCSU Chemical Engineering ("Wilder"). Crating Cataract discloses all of the limitations of claims 5-7 with the exception of the use of dibenzylidene sorbitol.

Dibenzylidene sorbitol is a known gelling agent which forms three dimensional fibrillar networks in organic substances, as disclosed by Wilder. It would have been obvious to one of ordinary skill

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in the relevant art to modify the model disclosed by Creating Cataract by providing dibenzylidene sorbitol for the purpose of hardening the eye to produce a simulated cataract.

Response to Arguments

8. Applicant's arguments filed on August 22, 2002 have been fully considered but they are not persuasive. With respect to the arguments concerning the rejection under 35 USC 102 of claim 1, the use of the word "type" in the language relied upon by applicant ("self hardening type chemicals") is vague and broad, and does not sufficiently limit the scope of the claim to overcome the cited prior art, particularly in light of the fact that claim 1 does not define "self hardening type chemicals" in such a way as to make clear what physical processes are occurring. The chemicals disclosed by Sugiura are ("self hardening type chemicals") in that they act in the manner of self hardening chemicals, by hardening the material in which they are injected. Claims 2, 3 and 5 are considered to be obvious over Sugiura because chemicals which are self-hardening in the manner discussed by applicant in the arguments are well known, as disclosed for example by Wilder, and would have been obvious to provide in the model disclosed by Sugiura for the purpose of allowing the user to more easily control the formation of the cataract.

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Conclusion


9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kurt Fernstrom whose telephone number is (703) 305-0303.

KF

October 29, 2002


Kien T. Nguyen
Primary Examiner